

Remarks/Arguments:

STATUS OF THE CLAIMS

Claims 6-11, 13, 14 and 16-19 are pending and currently under consideration.

Applicant thanks the Examiner for finding claim 13 allowable upon being rewritten in independent form.

Claims 6 and 16 have been amended to recite, in pertinent part, a board wherein the board has a general surfboard, snowboard, wakeboard, or skateboard shape. Support for the amendment is found throughout the specification including at Pg 1, Lines 6-10; Pg 2, Lines 16-19; Pg 3, Lines 11-13, Pg 8, Lines 12-15 and in Figures 1-10.

Claim 11 has been amended to recite, in pertinent part, a board wherein the securing device extends through the board from the lower surface to the upper surface. Support for the amendment is found at Pg 12, Lines 3-4 and in Figure 7A.

Claim 18 has been amended to more clearly describe the invention and correct the plurality of spherical inserts. Claim 18 has been amended to recite, in pertinent part, the spherical inserts rather than "spherical inserts."

DRAWINGS

The Examiner has objected to the drawings under 37 CFR 1.83(a) as not showing every feature of the invention specified in the claims. The Examiner states that the "spherical inserts corresponding to a different degree of balancing difficulty" of claim 18 must be shown or the feature cancelled from the claim. Applicant respectfully traverses.

37 CFR 1.83(a) states that a drawing in a nonprovisional application must show every feature of the invention specified in the claims. Applicant has amended claim 18 to correspond to the existing drawings which show every feature of the invention specified in the amended claim. In

particular, claim 18 has been amended to correct the plurality of spherical inserts. Claim 18 has been amended to recite, in pertinent part, the spherical inserts rather than "spherical inserts." A single insert is shown in Figures 7, 8 and 9.

Moreover, the specification provides context to the drawings. At Pg 15, Lines 1-12-16, the specification reads:

The method may also include placing the balancing insert on a platform as described above. The method may provide for various user skill levels in selecting the surface area of the concave region to accommodate a user's skill level, by sequentially increasing the method difficulty by increasing the surface area of the concave region, or increasing the size of the balancing insert.

Applicant respectfully submits that every claim limitation of claim 18, as amended, is shown in the drawings. Applicant respectfully requests that this rejection be withdrawn.

REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claim 18 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner states that claim 18 discloses "spherical inserts corresponding to a different degree of balancing difficulty" but fails to discuss this limitation in the specification or drawings. Applicant respectfully traverses.

The MPEP provides that the claims need only provide a reasonable degree of particularity and distinctness to comply with the provisions of 35 U.S.C. § 112, second paragraph. MPEP 2173.02 ([A] claim should only be declared indefinite when it "remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction...."). As interpreted by the Federal Circuit, the requirement to "distinctly" claim means that the claim only needs to be discernible to one of ordinary skill in the art. Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings, 370 F.3d 1354, 1366 (Fed. Cir. 2004).

As addressed above, Applicant has amended claim 18 to correspond to the existing drawings which show every feature of the invention specified in the amended claim. Moreover, the specification provides support for amended claim 18. See Pg 15, Lines 12-16 above.

Applicant respectfully submits that the meaning of claim 18, as amended, is readily discernible by a person skilled in the art. Applicant respectfully submits that every claim limitation of claim

18, as amended, is shown in the drawings and is supported in the specification. Applicant respectfully requests that this rejection be withdrawn.

REJECTION UNDER 35 U.S.C. § 102(b)

Claims 6, 7, 9 and 16 are rejected under 35 U.S.C. § 102(b) as being anticipated by Armer, Jr., U.S. Patent No. 4,191,371 ("Armer"). The Examiner states that Armer discloses a balance training device and inherently a method for exercising as substantially claimed. Applicant respectfully traverses.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. MPEP 2131, quoting Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). The elements must be arranged as required by the claim, although identity of terminology is not required. MPEP 2131, citing In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

Applicant respectfully submits that all elements of amended claims 6 and 16 are not found in Armer. Armer discloses a balancing apparatus having a main body in the shape of a sector of a sphere. Col. 2, Lines 17-19. Armer claims a balancing apparatus comprising a spherical fulcrum of a first diameter. Claim 1. Finally, Armer displays a balancing apparatus in Figure 1 in which the body has a round shape. Armer does not disclose a balancing apparatus wherein the apparatus has a general surfboard shape. Applicant has amended claims 6 and 16 to recite, in pertinent part, a board wherein the board has a general surfboard shape.

Applicant respectfully submits that this rejection fails because each and every element of claim 6 and 16 are not expressly or inherently described by Armer as required. Claims 7 and 9 depend from claim 6. As such, Applicant respectfully requests that the rejection of claims 6, 7, 9 and 16 as being anticipated under 35 USC 102(b) by Armer be withdrawn.

REJECTION UNDER 35 U.S.C. § 103(a)

Armer in view of Sasser

Claims 8 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Armer in view of Sasser, Jr., U.S. Patent No. 3,488,049 ("Sasser"). The Examiner states that Sasser discloses a similar training device with a board having a concave region with a substantially

oval/oblong or rectangular shape. The Examiner states it would have been obvious to modify the shape of Armer's concave region as long as it is still able to rotate in all directions. The Examiner further cites that "[a] change in the shape of a prior art device is a design consideration within the skill of the art." In re Dailey, 357, F.2d 669, 149 USPQ 47 (CCPA 1966). Applicant respectfully traverses.

As originally set forth by the Supreme Court in Graham v. John Deere, and as recently confirmed by the Supreme Court in KSR v. Teleflex, the subject matter of the claimed invention "as a whole" must be considered in determining whether the claimed invention is obvious. Graham v. John Deere Co. of Kansas, 383 US 1 (1966); KSR International Co. v. Teleflex, Inc., 127 S. Ct. 1727 (2007). In accordance therewith, the MPEP provides that when applying 35 U.S.C. §103, the following tenets of patent law must be adhered to: (A) The claimed invention must be considered as a whole; (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) The references must be viewed without the benefit of impermissible hindsight afforded by the claimed invention; and (D) Reasonable expectation of success is the standard with which obviousness is determined. See MPEP § 2141 (II) citing Hodosh v. Block Drug Co., Inc. 786 F2d 1136, 1143 (Fed. Cir. 1986). In addition, the prior art reference must be considered as a whole, including portions that teach away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983); MPEP 2141.02. Finally, when the prior art teaches away from a combination, that combination is more likely to be nonobvious. In re Gurley, 27 F.3d 551, 553 (Fed. Cir. 1994).

Applicant respectfully submits that the present invention is not rendered obvious by Armer in view of Sasser. The present invention, as amended, when viewed as a whole, is directed to a balance training device for use with surfboards and other related boards. The users of these boards (e.g. a surfboard) require balancing skills that include the ability to balance while moving their feet, and subsequently shifting their center of weight, over the board to simulate real life use. As such, the present invention describes a board that is shaped and sized like a surfboard and that rides on a single sphere to allow for movement in all directions.

Armer, when viewed as a whole, is directed to a more simple balancing apparatus. As stated above, Armer discloses a balancing apparatus in which the body has a round shape. More importantly, the foot support of Armer is "centrally located" and is "just large enough to comfortably accommodate the feet of the largest typical user." Col. 2, Lines 31-34. Similarly,

Sasser, when viewed as a whole, is directed to another simple balancing apparatus wherein the body is a elongated board (*i.e.* rectangle, oval or oblong). Sasser notes that the "novelty of [Sasser's invention] is thought to reside in providing a top side one the paned with precision located foot pads. Col. 2, Lines 14-15. As shown in Sasser's Figure 1, these foot pads are symmetrically located on the top side.

Clearly, both Armer and Sasser, teach one having skill in the art away from looking to either of these simple apparatuses to design a surfboard shaped balancing device that develops user balancing skills that include the ability to balance while moving their feet, and subsequently shifting their center of weight, over the board to simulate real life use. In particular, both Armer and Sasser require precise placement of a user's feet on their respective apparatus as described above. As such, a person skilled in the art would not have a reasonable expectation of success in designing a surfboard shaped balancing device that develops user balancing skills that include the ability to balance while moving their feet, and subsequently shifting their center of weight, over the board to simulate real life use by either Armer, Sasser or their combination.

Moreover, a change in the shape of a prior art device is a design consideration within the skill of the art **only** when the shape is insignificant. In re Dailey, 357, F.2d 669, 149 USPQ 47 (CCPA 1966). In In re Dailey, the patentee argued for the patentability of a nursing bottle by stating the shape configuration was distinguishable from prior art bottles. The Court found the argument unpersuasive because the "[a]ppellants have presented no argument which convinces us that the particular configuration of their container is significant." Id. at 49. Here, Applicant submits that the surfboard shape is significant. The shape of the present invention allows the user to balance while moving their feet, and subsequently shifting their center of weight, over the length of the board to simulate real life use.

Applicant respectfully submits that this rejection fails because the present invention is not rendered obvious by Armer in view of Sasser. As such, Applicant respectfully requests that the rejection of claims 8 and 10 as being obvious under 35 USC 103(a) by Armer in view of Sasser be withdrawn.

Armer in view of McGuinness

Claim 11 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Armer in view of McGuinness, U.S. Patent No. 6,168,551 ("McGuinness"). The Examiner states that McGuinness discloses a balance training device that includes a securing device and this it would have been obvious to an person of ordinary skill to combine the device with Armer. Applicant respectfully traverses.

In order to establish prima facie obviousness of a claimed invention under 35 U.S.C. 103(a), all of the claim limitations must be taught or suggested by the prior art. MPEP 2143.03, citing In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). All of the words in a claim must be considered in judging its patentability against the prior art. MPEP 2143.03, citing In re Wilson, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970).

Applicant respectfully submits that all elements of amended claim 11 are not found in the combination of Armer and McGuinness. Claim 11 has been amended to recite, in pertinent part, a board wherein the securing device extends through the board from the lower surface to the upper surface. Armer does not disclose a securing device. McGuinness discloses a securing device that straps over one end of the apparatus. However, neither disclose a securing device that extends through the board from the lower surface to the upper surface. Therefore, because all of the limitations of claim 11 has not been taught or suggested by the prior art, Applicant respectfully submits that claim 11 is not rendered obvious by Armer in view of McGuinness.

England in view of Sasser

Claims 6, 14 and 16-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over England, U.S. Patent No. 3,862,768 ("England") in view of Sasser. The Examiner states that the combination of England and Sasser makes obvious a platform to allow a user to ride a board in multiple directions. Applicant respectfully traverses.

Applicant respectfully submits that the present invention is not rendered obvious by England in view of Sasser. As previously stated, the present invention, as a whole, is directed to a balance training device, shaped generally like a surfboard, that allow the user the ability to balance while moving their feet to a different location on the device, and subsequently shifting their center of weight, over the board to simulate real life use. As such, the present invention

describes a board that is shaped and sized like a surfboard and that rides on a single sphere to allow for movement in all directions.

As previously stated, Sasser, when viewed as a whole, is directed to a simple balancing apparatus wherein the body is a elongated board (*i.e.* rectangle, oval or oblong). Sasser notes that the "novelty of [Sasser's invention] is thought to reside in providing a top side one the paned with precision located foot pads. Col. 2, Lines 14-15. As shown in Sasser's Figure 1, these foot pads are symmetrically located on the top side. Similarly, England, when viewed as a whole, is directed to another simple balancing apparatus. England discloses a balancing apparatus that is circular and comprises a "footing trough." Col. 1, Lines 57-60. The user of England's device "assumes a position astride [the] hat shaped balancing board with his feet placed in opposite parts of [the] foot positioning trench." Col. 5, Lines 15-19.

Clearly, upon reading both England and Sasser, one skilled in the art would not be motivated to look to either simple apparatus to design a surfboard shaped balancing device that develops user balancing skills that include the ability to balance while moving their feet to a different location on the device, and subsequently shifting their center of weight, over the board to simulate real life use. In fact, both England and Sasser teach away from such a device by requiring precise placement of a user's feet on their respective apparatuses. As such, a person skilled in the art would not have a reasonable expectation of success in designing a surfboard shaped balancing device that develops user balancing skills that include the ability to balance while moving their feet, and subsequently shifting their center of weight, over the board to simulate real life use by considering either Armer or Sasser.

Applicant respectfully submits that this rejection fails because the present invention is not rendered obvious by England in view of Sasser. Claims 18 and 19 are dependent upon claim 16. As such, Applicant respectfully requests that the rejection of claims 6, 14 and 16-19 as being obvious under 35 USC 103(a) by England in view of Sasser be withdrawn.

CONCLUSION

The foregoing is believed to be fully responsive to the November 6, 2007 office action. The embodiments presented are believed to be allowable over the prior art of record. Consideration and allowance of the claims is respectfully requested.

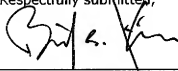
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In the event that any fee has been inadvertently overlooked and is required, the Commissioner is hereby authorized to charge any required fee or credit any overpayment to **Deposit Account No. 50-3570**.

If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is cordially requested to telephone the undersigned. If the Examiner has any questions in connection with this paper, or otherwise if it would facilitate the examination of this application, please call the undersigned at the telephone number below.

Respectfully submitted,



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